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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,278	04/24/2001	Kenneth Kiron	3001 P 016	9675

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Edward L. Bishop
Wallenstein & Wagner, Ltd.
53rd Floor
311 South Wacker Drive
Chicago, IL 60606-6630

EXAMINER

HAVAN, THU THAO

ART UNIT PAPER NUMBER

3624

DATE MAILED: 04/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/843,278

Applicant(s)

KIRON ET AL.

Examiner

Thu Thao Haven

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53 and 90-190 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53 and 90-190 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/27/01; 4/14/03</u> . | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Drawings

The Examiner accepts the drawings filed on July 16, 2001.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **53** and **90-190** are rejected under 35 U.S.C. 102(e) as being anticipated by Champion et al. (US 5,126,936).

Re claims **53** and **135**, Champion teaches a method comprising the steps of:

creating a derivative based on a unit investment trust having a number of shares and having a portfolio comprising of securities within a subgroup of a group of securities and satisfying an investment objective (col. 1, lines 1-35; figs. 1e and 7a-7b; Campion discloses managing a goal directed investment accounts in relation to many instruments such as derivatives);

trading the derivative on an exchange at a price related to the securities within the portfolio (col. 3, lines 8-11; col. 4, lines 1-6; col. 11, lines 1-19); and

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outputting an indication of the price in a humanly readable format (figs. 1e and 7a-7b; Campion discloses output means for interactive communication to market and system participants).

Re claims **90, 103, 114, 125, 136, 148, 159, 170, and 181**, Champion teaches an index of the group of securities (fig. 7b (element 16)). In figure 7b, Campion discloses market index in relation to investment in securities.

Re claims **91, 104, 115, 126, 137, 149, 160, 171, and 182**, Champion teaches aggressive growth (col. 11, lines 14-29).

Re claims **92-94, 105-107, 116-118, 127-129, 138-140, 150-152, 161-163, 172-174, and 183-185**, Champion teaches growth and income (col. 2, lines 41-60). Campion discloses growth and income in investment.

Re claims **95, 108, 119, 130, 141, 153, 164, 175, and 186**, Champion teaches investing in a sector (figs. 1e and 7a-7b).

Re claims **96, 109, 120, 131, 142, 154, 165, 176, and 187**, Champion teaches equity (col. 2, lines 45-48; fig. 7b (element 11)). In figure 7b, Campion discloses equity.

Re claims **97, 110, 121, 132, 143, 155, 166, 177, and 188**, Champion teaches small companies (abstract).

Re claims **98-99, 111-112, 122-123, 133-134, 144-145, 156-157, 167-168, 178-179, and 189-190**, Champion teaches bonds (figs. 1c-1e).

Re claim **100**, Champion teaches listing the derivative on an exchange (col. 1, lines 15-35; figs. 1e and 7a-7b).

Re claims **101, 113, 124, 146, 158, 169, and 180**, Champion teaches a method comprising the steps of:

listing a derivative based on a unit investment trust having a plurality of shares and a portfolio comprising of securities that satisfy an investment objective, the securities within the portfolio being weighted (col. 6, line 50 to col. 7, line 41; col. 5, lines 40-57; figs. 1e and 7a-7b; Champion list the investment in relation to an investor's portfolio);

trading the derivative on an exchange at a price related to the securities within the portfolio (col. 1, lines 36-49; col. 2, lines 22-40; col. 3, lines 8-12; col. 4, lines 1-21; col. 11, lines 1-29; Champion discloses managing a goal directed investment accounts in relation to many instruments such as derivatives); and

displaying in real time the price that the derivative was traded on the exchange (col. 5, lines 30-39; col. 6, lines 33-50; fig. 4; Champion disclose current time and time tagged that correspond to real time).

Re claims **102 and 147**, Champion teaches electronically trading the derivative (fig. 2). In figure 2, Champion discloses electronic exchange by computer system thru a modem.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Atkins, US 5,644,727

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu Thao Havan whose telephone number is (571) 272-8111. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (571) 272-6747. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct-uspto.gov/>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

TTH
4/16/2006

VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

